IN THE CLAIMS

Please cancel claims 4, 5, 10, 11, and 18 without prejudice or disclaimer.

Please rewrite claim 1 as follows (a marked-up copy of the claim, showing the amended subject matter, is set forth in the attached Appendix):

B1

1. (Amended) An incombustible resin composition comprising a silicone oligomer which comprises an aromatic group, a metal hydrate which comprises aluminum hydroxide, and a resin material, wherein the metal hydrate is 20% by weight or more in the total solids of the resin composition.

Please add new claims 20 and 21 as follows:

B2

20. The incombustible resin composition according to claim 1, wherein each siloxane unit of the silicone oligomer has at least one aromatic group.

21. The incombustible resin composition according to claim 1, wherein the aluminum hydroxide has an average particle diameter of 5 μm or less.

REMARKS

Status of the Claims

Claims 1-19 stand rejected. Applicants now cancel claims 4, 5, 10, 11, and 18 without prejudice or disclaimer. The subject matter of claims 4 and 10 has been incorporated into amended claim 1. Claim 11 is replaced with new claim 20. Claim 5 is replaced with new claim 21.

Response to Claim Objection

Claim 11 is objected to because the word "least" was misspelled. Applicants thank the Examiner for pointing out this typographical error and have replaced claim 11 with new claim 20, which is believed to render the objection moot. Reconsideration and withdrawal of the

objection are respectfully requested.

Response to Indefiniteness Rejection and Specification Objection

Claims 1-19 are rejected under 35 U.S.C. § 112, ¶ 2, as allegedly being indefinite. The rejection states that the recitation of the term "oligomer" renders the claims indefinite. Specifically, the rejection states that is used by the claims to encompass polymers containing 2 to 7000 monomer units, while the accepted definition is allegedly limited to 2-4 monomer units. Related to this rejection, the specification is objected to on the grounds that the disclosure allegedly uses an incorrect definition of "oligomer."

Applicants respectfully traverse the rejection. Initially, Applicants respectfully note that the legal standard applied in the rejection is based on very old law. Longstanding case law, which supercedes the standard applied in the rejection provides that an Applicant can be his own lexicographer in order to use a term in a manner contrary to its generally accepted meaning so long as the public is put on notice that the standard meaning does not apply. *See, e.g., Elekra Inst. SA v. O.U.R. Scientific Int'l Inc., 54 USPQ2d 1910, 1913 (CAFC 2000) (citing Process Control Corp. v. HydReclaim Corp.*, 52 USPQ2d 1029, 1033 (CAFC 1999)).

Further, the factual premise of the rejection is incorrect. That is, Applicants do not limit the term "oligomer" in the claims to mean a degree of polymerization of 2-7000 units. In this regard, the rejection cites a passage in the specification (page 5, lines 18-20) which states, as one of many aspects, that the invention provides an oligomer having 2-7000 monomer units. The specification does not state or suggest that this is the definition of "oligomer." However, it does clearly demonstrate that Applicants' use of "oligomer" includes both short and long molecules. Therefore, Applicants respectfully submit that the requirements of the law regarding terminology are met and that one skilled in the art would recognize that the claims are not intended to be limited to any specific range of polymerization. Reconsideration and withdrawal of the rejection and objection to the specification are respectfully requested.

Response to FURUKAWA Rejections

Claims 1, 4-6, and 8-11 are rejected under 35 U.S.C. § 102(e)(2) or 103(a) as allegedly

anticipated by or obvious over U.S. Patent No. 6,303,681 to Furukawa et al. ("FURUKAWA").

FURUKAWA is available as prior art under 35 U.S.C. § 102(e) as of its U.S. filing date, *i.e.*, September 15, 2000. Applicants respectfully traverse the rejections on the grounds that the claimed invention was reduced to practice by Applicants before the effective date of FURUKAWA under 35 U.S.C. § 102(e).

Initially, Applicants note that the foreign priority application for this case (JP 2000-313720) was filed October 13, 2000, only one month after the effective date of FURUKAWA. Applicants are submitting herewith a verified English language translation of the priority document, and accordingly, respectfully request benefit of its October 13, 2000 filing date.

Furthermore, Applicants are submitting herewith the Declaration of Nozomu Takano Under 37 C.F.R. § 1.131(the "Declaration"), evidencing reduction to practice of the present invention prior to September 15, 2000. More specifically, the Declaration of inventor Takano states that prior to September 15, 2000, his group had reduced to practice an incombustible resin composition comprising a silicone oligomer, a resin material, and a metal hydrate, wherein the metal hydrate comprises at least 20% by weight of the solids of the resin composition.

Exhibit A to the Declaration is a copy (in Japanese) of a Draft Specification that was prepared before September 15, 2000. Exhibit C to the Declaration is a partial English language translation of the Draft Specification. The examples of the Draft Specification are not translated but are the same as those in the priority document, which are translated. Documenting the creation and existence of the Draft Specification is a copy of a computer "file property" for the Draft specification (and an English language translation thereof), which is attached to the Declaration as Exhibit B. Although redacted, the file property evidences a date of creation of the Draft Specification prior to September 15, 2000. As further evidence, Exhibit D to the Declaration is a partially redacted Letter of Request for a patent application from the inventors to their attorneys. The Letter of Request, although redacted, was sent prior to September 15, 2000, with the Draft Specification as an attachment. Exhibit D includes a partial English language translation of the Japanese text.

The Draft Specification discloses, *inter alia*, the same twenty-four examples that are disclosed in the foreign priority document, and includes an incombustible resin composition

comprising a silicone oligomer, a resin material, and a metal hydrate, wherein the metal hydrate comprises at least 20% by weight of the solids of the resin composition. Accordingly, it is submitted that Applicants have established reduction to practice of the claimed invention prior to September 15, 2000.

In view of the above, Applicants respectfully submit that FURUKAWA should no longer qualify as prior art under 35 U.S.C. § 102(e). Reconsideration and withdrawal of the rejection are respectfully requested.

Response to TAKANO Rejections

Claims 1-5 and 8-19 are rejected under 35 U.S.C. § 102(a) or 103(a) as allegedly anticipated by or obvious over WO 97/01595 and US 2001/0053447 to Takano et al. ("TAKANO"). The U.S. publication is relied on as a translation of the WO document. The rejection states that TAKANO discloses a resin composition, comprising a silicone oligomer, a metal hydrate, and a resin material, wherein the metal hydrate is 20% by weight or more of the total solids in the composition. The rejection further asserts that TAKANO discloses the features of the dependent claims, including resin types, specific metal hydrates, particle sizes, etc. Although TAKANO does not disclose that the resin is incombustible, the rejection states that this would be an inherent property thereof.

Applicants respectfully traverse the rejections on the merits. Claim 1, for example, recites an incombustible resin composition comprising a silicone oligomer which comprises an aromatic group, a metal hydrate which comprises aluminum hydroxide, and a resin material, wherein the metal hydrate is 20% by weight or more in the total solids of the resin composition.

First, Applicants respectively submit that incombustibility is not an inherent feature of the TAKANO disclosure, as is suggested in the rejection. Incombustibility is a substantive feature of the claimed invention, just as much as the other recited elements are. That is, a composition comprising an aromatic group, a metal hydrate which comprises aluminum hydroxide, and a resin material, wherein the metal hydrate is 20% by weight or more in the total solids of the resin composition would not satisfy the claims unless it is also incombustible. In order for this claimed feature to be inherent, it must be a necessary result of practicing the

applied art, and not a matter of possibilities. Thus, while a chemical composition and it's properties may not be separable, this axiom only begs the question because there is no citation in the rejection of an embodiment in TAKANO that is inherently incombustible, nor a citation of a teaching of how to make an incombustible composition. Thus, even if a composition that could be made within the scope of TAKANO might be incombustible, there is no such teaching therein. By analogy, if an applied document discloses a genus of chemicals, a claimed subgenus thereof which has biological activity is not necessarily inherent in the applied document, because the biological activity is not a necessary result of the applied document even though its disclosure encompasses the claimed active compounds. Applicants respectfully submit that this reason alone is sufficient to demonstrate that the claimed invention is not disclosed or suggested in TAKANO.

Second, TAKANO does not appear to disclose or suggest, *inter alia*, the invention as claimed comprising a metal hydroxide including aluminum hydroxide, wherein the metal hydrate is 20% by weight or more in the total solids of the resin composition. TAKANO generally discloses an inorganic filler in an amount of 10 to 100 parts by weight, and separately, mentions aluminum hydroxide. These are essentially laundry lists of components and amounts as it relates to the present claims, without any guidance with respect to the use of aluminum hydroxide or its amount. Significantly in this regard, there is no teaching with regard to incombustibility. Thus. it would require unmotivated "picking and choosing" of disclosures in order to attain the amount of aluminum hydroxide. Applicants respectfully submit that this reason is independently sufficient to demonstrate that the claimed invention is not disclosed or suggested in TAKANO.

For at least the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the rejection.

Response to YAMAMOTO Rejection

Claims 1, 4-7, and 9 are rejected under 35 U.S.C. § 102(e)(2) as allegedly being anticipated by U.S. Patent No. 6,277,908 to Yamamoto ("YAMAMOTO"). The rejection states that YAMAMOTO discloses the limitations of the rejected claims, specifically, *e.g.*, at column 4, lines 4-48.

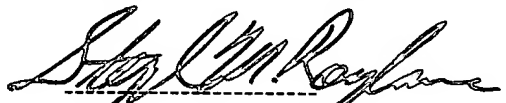
Applicants respectfully submit that the rejection is moot in view of the new claims. Specifically, the new claims incorporate the subject matter of original claim 10, which claim was not rejected. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

In view of the above, Applicants respectfully submit that all of the pending claims are allowable in their present form, and that the application is otherwise in condition for allowance. The Examiner is respectfully requested to withdraw the rejections and, as the next official action, to provide a Notice of Allowance.

If any issues remain which can be resolved by a telephone conference, or should the Examiner have any questions or comments regarding this matter, the Examiner is respectfully invited to contact the undersigned at the telephone number shown below.

Respectfully submitted,
Nozomu TAKANO et al.



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P21547.A06

APPENDIX
(Marked-Up Copy Showing Claim Amendments)

- - - 1. (Amended) An incombustible resin composition[, which comprises] comprising a silicone oligomer which comprises an aromatic group, a metal hydrate which comprises aluminum hydroxide, and a resin material [as essential components], wherein the metal hydrate is 20% by weight or more in the total solids of the resin composition. - - -